UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,248	02/13/2001	Peter Brittingham	246400.0164	2566

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EXAMINER
PHILLIPS, HASSAN A

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/781,248	BRITTINGHAM ET AL.
	Examiner	Art Unit	
	Hassan Phillips	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *28 April 2005*.

2a) ☐ This action is **FINAL**.　　　　2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3-10,12-19 and 21-27* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,3-10,12-19 and 21-27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the Request for Continued Examination (RCE),
amendments, and remarks filed on April 28, 2005.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee
set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this
application is eligible for continued examination under 37 CFR 1.114, and the fee set
forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action
has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April
28, 2005, has been entered.

Response to Arguments

3. Applicant's arguments filed April 28, 2005 have been fully considered but they
are not persuasive. Applicant argues that: The combination of Tracton and Bradley fail
to teach or suggest the limitation of "storing a certification file in said client computer
only if said client computer is determined to have said sufficient performance capability".
Applicant also argues that one of skill in the art would not be motivated to combine
Bradley with Tracton. Examiner respectfully disagrees.

4. Regarding Applicants argument that the combination of Tracton and Bradley
fail to teach or suggest the limitation of "storing a certification file in said client computer

only if said client computer is determined to have said sufficient performance capability",

Examiner asserts that Tracton teaches determining whether a client computer has a

sufficient performance capability to utilize an on-line service based on at least one

performance parameter, (col. 3, lines 62-65); and storing a client identifier (or

certification file) (80), in the client computer if the client computer has sufficient

performance capability, the file being accessible by the server, (col. 3, lines 66-67, and

col. 4, lines 1-13). Although the disclosed method of Tracton shows substantial features

of the claimed invention, if fails to expressly disclose: **only** storing the certification file if

the client computer is determined to have sufficient performance capability.

Nevertheless, the logic for storing a file based on a determination of sufficient

performance capability was well known at the time of the present invention, and would

have been obvious to implement by slightly modifying the teachings of Tracton. In the

previous action, Examiner used the teachings of Bradley to show how such a

determination was used in a method and apparatus for linking external information to a

network management system. Specifically, Bradley teaches storing a certification file

(118) in a server computer (112), **only** if the certification file is determined to have

sufficient performance capability, (col. 7, line 10 through col. 8, line 55); the certification

file being accessible to a client **only** if the certification file has been certified, (col. 8,

lines 56-65).

        5. In response to applicant's argument that there is no suggestion to combine

the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of Bradley (col. 7, line 10 through col. 8, line 65) show knowledge generally available to one of ordinary skill in the art would suggest that modifying the teachings of Tracton (col. 3, line 66 through col. 4, line 13) would have been obvious.

6. Furthermore, the Examiner has interpreted the claim language as broadly as possible. It is also the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in a manner that distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterated the need for Applicant to define the claimed invention more clearly and distinctly. Accordingly the references supplied by the examiner in the previous office action covers the claimed limitations. The rejections are thus sustained. Applicant is requested to review the prior art of record for further consideration.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been obvious at the time the invention was made to
a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

8. Claims 1, 3-7, 10, 12-16, 19, 21-25, are rejected under 35 U.S.C. 103(a) as

being unpatentable over Tracton et al. (hereinafter Tracton), U.S. patent 6,470,378 in

view of Bradley et al. (hereinafter Bradley), U.S. patent 6,584,507 (referenced in

previous office action and not relied upon).

9. In considering claims 1 and 10, Tracton discloses a method of querying a

client computer by a server over a communication network to determine whether the

client computer has sufficient performance capability in order to utilize an on-line

service, comprising: allowing a query program to be downloaded to the client computer,

the query program, upon execution, querying the client computer for at least one

performance parameter, (col. 3, lines 55-58); transmitting at least one performance

parameter to the server, (col. 3, lines 58-62); determining whether the client computer

has a sufficient performance capability to utilize the on-line service based on the at least

one performance parameter, (col. 3, lines 62-65); storing a client identifier (or

certification file) 80, in the client computer if the client computer has sufficient

performance capability, the file being accessible by the server, (col. 3, lines 66-67, and col. 4, lines 1-13).

Although the disclosed method of Tracton shows substantial features of the claimed invention, if fails to expressly disclose: **only** storing the certification file if the client computer is determined to have sufficient performance capability.

10. Nevertheless, in a similar field of endeavor, Bradley discloses a method and apparatus for linking external information to a network management system comprising: storing a certification file 118 in a server computer 112, **only** if the certification file is determined to have sufficient performance capability, (col. 7, line 10 through col. 8, line 55); the certification file being accessible to a client **only** if the certification file has been certified, (col. 8, lines 56-65).

Thus, given the teachings of Bradley, it would have been obvious to one of ordinary skill in the art, to modify the teachings of Tracton to store the certification file in the client computer **only** if the client computer is determined to have sufficient performance capability. This would have provided an efficient means for verifying the client computer meets a minimum performance capability before proceeding to use the online service, Bradley col. 8, lines 56-65. This further would have made the method taught by Tracton more efficient since the server would no longer need to communicate with the client through a registry, or tailor data to meet the capabilities of the client, Tracton, col. 3, line 66 through col. 4, line 13.

11. In considering claims 3 and 12, the method of Tracton further provides a means for determining whether the client computer was previously certified, the client computer being previously certified if a certification file 80, is stored in the client computer. See col. 3, lines 55-67, and col. 4, lines 1-13.

12. In considering claims 4 and 13, the method of Tracton further discloses the query program being configured to issue one or more application program interface function calls to an operating system of the client computer, the operating system returning at least one performance parameter in response to the one or more application program interface function calls. See col. 5, lines 30-57.

13. In considering claims 5 and 14, it is implicit in the method taught by Tracton that certification criteria is contained in a storage of the server. See col. 3, lines 62-65.

14. In considering claims 6 and 15, it is also implicit in the method taught by Tracton that in the step of determining whether the client computer has sufficient performance capabilities, comparing at least one performance parameter to the certification criteria. See col. 3, lines 62-65.

15. In considering claims 7 and 16, the method of Tracton further discloses providing a remediation to a user of the client computer if it was determined that the client computer does not have sufficient performance capability. See col. 3, lines 62-65.

16. In considering claim 19, Tracton discloses a system for remotely querying a client computer by a server over a communication network, comprising: a communication network 104, (see Fig. 4); a server configured to allow a query program to be downloaded to the client computer, the query program, upon execution, querying the client computer for at least one performance parameter from the querying program, and determining whether the client computer has a sufficient performance capability to utilize an on-line service based on the at least one performance parameter, (col. 3, lines 55-65); storing a client identifier (or certification file) 80, in the client computer if the client computer has sufficient performance capability, the file being accessible by the server, (col. 3, lines 66-67, and col. 4, lines 1-13).

Although the disclosed method of Tracton shows substantial features of the claimed invention, if fails to expressly disclose: **only** storing the certification file if the client computer is determined to have sufficient performance capability.

17. Nevertheless, in a similar field of endeavor, Bradley discloses a method and apparatus for linking external information to a network management system comprising: storing a certification file 118 in a server computer 112, **only** if the certification file is determined to have sufficient performance capability, (col. 7, line 10 through col. 8, line 55); the certification file being accessible to a client **only** if the certification file has been certified, (col. 8, lines 56-65).

Thus, given the teachings of Bradley, it would have been obvious to one of ordinary skill in the art, to modify the teachings of Tracton to store the certification file in

the client computer **only** if the client computer is determined to have sufficient

performance capability. This would have provided an efficient means for verifying the

client computer meets a minimum performance capability before proceeding to use the

online service, Bradley col. 8, lines 56-65. This further would have made the method

taught by Tracton more efficient since the server would no longer need to communicate

with the client through a registry, or tailor data to meet the capabilities of the client,

Tracton, col. 3, line 66 through col. 4, line 13.

18. In considering claim 21, the method of Tracton further provides a means for

determining whether the client computer was previously certified, the client computer

being previously certified if a certification file 80, is stored in the client computer. See

col. 3, lines 55-67, and col. 4, lines 1-13.

19. In considering claim 22, the method of Tracton further discloses the query

program being configured to issue one or more application program interface function

calls to an operating system of the client computer, the operating system returning at

least one performance parameter in response to the one or more application program

interface function calls. See col. 5, lines 30-57.

20. In considering claim 23, it is implicit in the method taught by Tracton that

certification criteria are contained in storage of the server. See col. 3, lines 62-65.

21. In considering claim 24, it is also implicit in the method taught by Tracton that in the step of determining whether the client computer has sufficient performance capabilities, comparing at least one performance parameter to the certification criteria. See col. 3, lines 62-65.

22. In considering claim 25, the method of Tracton further discloses providing a remediation to a user of the client computer if it was determined that the client computer does not have sufficient performance capability. See col. 3, lines 62-65.

23. Claims 8, 9, 17, 18, 26, 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracton in view of Bradley, and further in view of Bland et al. (hereinafter Bland), U.S. patent 5,732,218.

24. In considering claims 8, 17, and 26, although the disclosed system of Tracton and Bradley shows substantial features of the claimed invention, if fails to expressly disclose: storing a client computer database in the storage of the server.

Nevertheless, storing a client computer database in the storage of a server was well known in the art at the time of the present invention. This is exemplified in a method, taught by Bland, that discloses a management data gathering system comprising: storing a client computer database 123 in the storage of a server 103, (col. 5, lines 62-66).

Given the teachings of Bland, it would have been obvious to one of ordinary skill in the art, to modify the teachings of Tracton to have a client computer database reside within a server's storage. This would have provided a more efficient means for the server to access the pre-discovered performance parameters of the client computer, Bland, col. 2, lines 12-16.

25. In considering claims 9, 18, and 27, the method of Bland further teaches updating the client computer database, (col. 2, lines 25-26). The motivation for modifying the teachings of Tracton with the teachings of Bland would be the same as that indicated in the consideration of claims 8, 17, and 26.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dodrill et al., U.S. Patent 6,738,803, discloses a browser that stores capabilities of a user device in a capabilities table.

Wrench, Jr., U.S. Patent Pub. No. 2002/0104025, discloses storing a certificate in a client for secure communication between a client and a server.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

HP/
7/13/05

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER